

REMARKS

I. Status of the Claims

After entering the above amendments, claims 1, 20-37 are pending in this application. Claims 1-19 stand rejected. Claims 2-19 have been canceled, and claims 20-37 have been added. Claim 1 has been amended to include the limitation of original claim 9, thus, written description support for amended claim 1 can be found in original claim 9. New claims 20-37 cover essentially the same subject matter as original claims 2-19, but have been drafted in even further accordance with the requirements of 35 U.S.C. §§ 101 and 112, second paragraph. Thus, written description support for new claims 20-37 can be found in original claims 2-19.

II. Rejections under 35 U.S.C. § 112, second paragraph

Claim 18 has been rejected under 35 U.S.C. § 112, second paragraph as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. *Office Action* at p. 3. Additionally, claims 2-17 have been rejected under 35 U.S.C. § 112, second paragraph as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. *Id.* at p. 4. Applicants have canceled claims 2-18 and submit that those rejections are inapplicable to new claims 20-37.

III. Rejections under 35 U.S.C. § 101

Claim 18 is rejected under 35 U.S.C. § 101 because the claimed recitation of a use, without setting forth any steps involved in the process, allegedly results in an

improper definition of a process. *Id.* at p. 4-5. Applicants have canceled claim 18 and submit that those rejections are inapplicable to new claims 20-37.

IV. Rejections under 35 U.S.C. § 102(b)

Claims 1-4 and 19 are rejected under 35 U.S.C. § 102(b) as being allegedly unpatentable by U.S. Patent No. 4,940,576 by Walsh (hereinafter, "Walsh"), as evidenced by the Merquat 100 product information guide and U.S. Patent No. 5,744,062 by Dahms *et al.* (hereinafter, "Dahms") *Id.* at p. 5-8. Regarding claim 1, the Examiner points to Example 4 of Walsh, alleging that it contains each element of that claim. *Id.* at pp. 5-6.

Applicants submit that Walsh does not teach every element of claim 1 as currently amended, and therefore requests that this rejection of claim 1 be withdrawn. In particular, under 35 U.S.C. § 102(b), a patent shall be allowed unless "the invention was patented or described in a printed publication in this . . . country . . . more than one year prior to the date of application for patent." Implicit in this exception is that any reference upon which an Examiner relies to reject a claim under § 102(b) must teach every element of that claim. M.P.E.P. § 2131, *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

The Examiner has only pointed to Example 4 as evidence of Walsh teaching the claimed weight ratio of the at least one salt to the at least one cationic polymer. However, that example does not meet two further limitations of claim 1 that have been added by amendment.

First, that example contains 2.6% by weight of an anionic surfactant, which is outside the claimed range of amended claim 1.

Second, as Walsh itself states, Example 4 is not a water-in-water emulsion. Instead, it is a clear single-phase liquid hair rinse conditioner composition comprising a water-soluble ionized polymer and an ionic surfactant of opposite charge. Col. 1, ll. 33-36. This teaching of Walsh is further supported by the comparative testing submitted herewith in the Declaration under 37 C.F.R. § 1.132 ("Declaration"), which shows that the composition of Example 4 is not a water-in-water emulsion.

Because Walsh fails to teach a composition that meets all of the limitations of claim 1 as presently amended, it does not anticipate amended claim 1. Also, because new claims 20-37 all depend from amended claim 1, Walsh does not anticipate those claims. Therefore, Applicants respectfully request that the rejection be withdrawn.

V. Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claim 1-5 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 4,940,576 (hereinafter '576) by Walsh. *Office Action*. at p. 9. As described above, the Examiner alleges that Walsh teaches all of the composition components recited in claim 1, and that Example 4 provides a composition that meets the other limitations of claim 1, including the amount of each component, the weight ratio of salt to cationic polymer, and the requirement that the composition be a water-in-water emulsion.

Regarding the allegation that Walsh teaches water-in-water emulsions, Applicants respectfully disagree with the Examiner's position. To the contrary, the

compositions of Walsh have been shown by Applicants not to be water-in-water emulsions, and Walsh expressly teaches away from water-in-water emulsion compositions. See Declaration at paragraphs 8-10. The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (2007), the Supreme Court confirmed that the “framework for applying the statutory language of §103” was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) secondary considerations. 148 U.S.P.Q. at 467. The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. See *Graham*, 148 U.S.P.Q. 467; see also *KSR*, 82 U.S.P.Q. 2d at 1388. As articulated in *KSR*, part of this evaluation involves determining “whether there was an apparent reason to combine” the prior art elements relied upon to establish obviousness. 82 U.S.P.Q. 2d at 1369.

The comparative testing submitted herewith in the Declaration is between composition A, created according to Example 4 of Walsh, and composition B, an embodiment within the scope of amended claim 1. The difference between these two compositions lies in their percentage of sodium lauryl ether sulphate, anionic surfactant: composition A comprises 2.6 % of sodium lauryl ether sulphate whereas composition B comprises 20% of that surfactant, an amount within the range of amended claim 1.

The Declaration contains images of both compositions A and B. Those images show that composition A is a clear and fluid solution and not a water-in-water emulsion. In contrast, composition B within the scope of amended claim 1 is a water-in-water emulsion containing droplets.

Indeed, Walsh itself teaches away from water-in-water emulsion compositions. Walsh expressly teaches that “according to the present invention there is provided an aqueous clear single-phase liquid hair rinse conditioner composition.” Col. 1, ll. 33-35. Example 4 is also said to be a clear single-phase hair rinse conditioner. Col. 7, ll 57-58. All of those teaching are in direct contradiction to the water-in-water emulsion compositions of the present claims.

Additionally, although the Examiner notes that Walsh teaches the presence of a lamellar liquid crystalline phase, those liquid crystals are not present in the compositions formulated according to the Walsh invention. Col. 1, ll. 37-44 and 49-54. Instead, Walsh teaches that the liquid crystals only form after the compositions of the invention have been “substantially diluted”. *Id.*, Col. 5, ll. 48-51. That further supports the direct teaching of single-phase compositions in Walsh. Col. 5, ll. 48-51. And, of course, after that dilution, the amount of sodium lauryl ether sulphate (3EO) in Example 4 of Walsh is far less than 2.6% and thus end farther away from the 4% lower limit in amended claim 1.

The teaching away from water-in-water emulsion compositions found in Walsh, including in Example 4, overwhelmingly outweighs any inference of obviousness that may be made based on similarities that may exist between amended claim 1 and Example 4. Additionally, the Examiner has not provided any other teaching that

contradicts Walsh and might provide the necessary motivation to modify Walsh.

Therefore, Applicants submit that the Examiner has not established a prima facie case of obviousness, and requests that the rejection of claim 1 under § 103(a) be withdrawn.

V. Conclusion

In view of the foregoing amendments and remarks, and the enclosed declaration, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

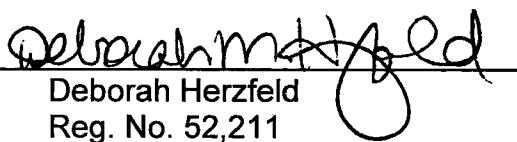
If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully urged to contact Applicant's undersigned counsel at 202-408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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